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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/696,751	10/29/2003	John Frederick Porter	11277-0039	7560
8933	7590	07/17/2007		
DUANE MORRIS, LLP IP DEPARTMENT 30 SOUTH 17TH STREET PHILADELPHIA, PA 19103-4196			EXAMINER MAKI, STEVEN D	
			ART UNIT 1733	PAPER NUMBER
			MAIL DATE 07/17/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Advisory Action</b> <b>Before the Filing of an Appeal Brief</b>	<b>Application No.</b> 10/696,751	<b>Applicant(s)</b> PORTER, JOHN FREDERICK	
	<b>Examiner</b> Steven D. Maki	<b>Art Unit</b> 1733	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 03 July 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

#### AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see Advisory Action Attachment. (See 37 CFR 1.116 and 41.33(a)).

4. ☒ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: \_\_\_\_\_.
- Claim(s) objected to: \_\_\_\_\_.
- Claim(s) rejected: 17, 18 and 21-37.
- Claim(s) withdrawn from consideration: 19 and 20.

#### AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

#### REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see Advisory Action Attachment.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_
13. ☐ Other: \_\_\_\_\_.

Advisory Action Attachment

**new issues**

The new issues include:

(1) in step (a) of claim 17, deleting "wherein the thin, porous nonwoven web comprises alkali resistant polymer fibers having thereon a hydrophilic material to enhance wetting of the thin, porous nonwoven web by the layer of hydraulic cementitious material, and adhesion of thin, porous nonwoven web to the layer of hydraulic cementitious material, and continuity of the layer of hydraulic cementitious material about the reinforcement fabric";

(2) amending claim 17 to additionally require "penetrating the open mesh ... imbedding the open mesh in the layer" and "penetrating through the thin, porous nonwoven web ... embed the thin, porous web in the layer",

(3) adding "promoting penetration through the thin, porous nonwoven web", and

(4) in step (b) of claim 17, deleting "--with continuity--".

**remarks**

Applicant states "Claims 17-37 are readable on the elected species." (page 8 of after final amendment filed 7-3-07). Applicant is incorrect. In the response filed 2-22-07, applicant stated: "Claims 19 and 20 are not readable on the elected species..." (page 8 of response filed 2-22-07). Claims 17, 18 and 21-37 are therefore readable on the elected species whereas claims 19 and 20 are withdrawn claims.

Applicant argues that a combination of Berke et al with the other cited references does not pertain to Applicant's method. This argument is not persuasive. One of

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ordinary skill in the art is appraised by Canada that even when partial embedment of fibers of a fabric in cementitious material is desired, a wetting agent should be applied to the fabric (pages 13-14). Canada teaches that use of a "wetting agent" on fabric permits the composition to penetrate the fabric and results in a stronger bond being obtained (pages 13-14). Furthermore, one of ordinary skill in the cementitious art is appraised by Berke et al of the hydrophobic nature of polypropylene fibers and the requirement for a wetting agent to provide such hydrophobic polypropylene fibers with a desired surface tension characteristic. The wettability of the polypropylene fibers in a fabric for cementitious material is relevant to Newman et al's cement board making process since Newman et al's polypropylene fiber meltblown web (nonwoven fabric) is embedded in the cementitious slurry during manufacture of the cement board. Note Neuman et al's disclosure that slurries 91 and 93 are optional and Newman et al's teaching that the cementitious slurry creates a smooth surface (skin) on the cement board (col. 9 lines 32-35) in which melt blown webs (nonwoven fabrics) may be on both faces of the scrim (open mesh) of the facing sheet (col. 6 lines 1-3). When Canada and Berke et al are viewed as a whole, one of ordinary skill in the art would have readily understood that a wetting agent can and should be applied to fibers to facilitate their embedment in cementitious material. With respect to the desirability of embedment, it is emphasized that Mathieu discloses completely embedding a fabric in cementitious slurry (col. 6 lines 59-61, col. 17 lines 55-65). It is further emphasized that Galer (correctly identified by applicant as being US 4,450,022) suggests completely embedding woven mesh or nonwoven fabric in cementitious slurry so that a smooth

surface of the cementitious board can be obtained. A smooth surface is highly desired by Newman et al. See last two lines of abstract and col. 9 lines 32-35.

Applicant argues that applicant's claims pertain to a different problem (page 8 of after final amendment filed 7-3-07). This argument is not persuasive since "[u]nder the correct analysis, any need or problem known in the field of endeavor at the time of the invention and addressed by the patent can provide a reason for combining the elements in the manner claimed." KSR INTERNATIONAL CO. v. TELEFLEX INC. ET AL, page 16 of slip opinion by the Supreme Court of the United States dated April 30, 2007.

Applicant comments that Mathieu describes mesh embodiments at column 16 lines 43-47. Examiner comments that Mathieu's disclosure relating to mesh embodiments is found at column 13 lines 58-67, column 14 lines 1-67, column 15 lines 1-67, column 16 lines 1-47. Additional disclosure regarding mesh embodiments is found at for example col. 6 lines 48-61 and col. 17 lines 55-65 of Mathieu.

With respect to Newman et al, applicant argues that the window pane is formed on the mesh forming side of the web 20. This argument is not persuasive. The combination of the applied prior art to Newman et al, Mathieu and Galer provide ample motivation (smooth surface / better anchoring) to completely embed the facing sheet 10 of Newman et al in the cementitious material.

Applicant argues that a cementitious composition does not penetrate through Canada's porous fabric. Applicant directs attention to Canada's page 12 line 16, which recites "surface-reinforcing layer 14 of porous fabric". Contrary to applicant's arguments, Canada's cementitious material penetrates the fabric. At page 14 lines 1-5,

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Canada teaches "...the liquid polymer coating ["wetting agent"] will decrease the viscosity of the cementitious composition when it is poured into the form and this in turn permits the composition to penetrate the fabric ..." (emphasis added). Also, note Canada's disclosure that "[o]ne significant factor affecting penetration is the consistency of the cementitious composition. Preferably the consistency is selected so as to permit the cementitious composition to penetrate at least one half of the thickness of the fabric layer" (emphasis added).

With respect to claim 29, applicant argues that the fabric of Canada and the mesh of either Neuman, Mathieu or Galer do not involve a cement powder coating. This argument is not understood because each of Neuman, Mathieu and Galer teach coating a fabric with a cementitious slurry wherein the slurry comprises "cement powder" and "water".

The amendment filed 7-3-07 was filed within two months of the final rejection. However, box "1a)" instead of "1b)" was checked on PTOL 303 since (1) the amendment filed 7-3-07 is the second amendment after final and (2) PTOL-303 states "Examiner note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION." (emphasis added).

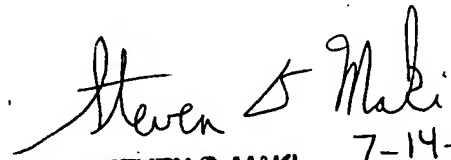
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven D. Maki whose telephone number is (571) 272-1221. The examiner can normally be reached on Mon. - Fri. 8:30 AM - 5:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on (571) 272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Steven D. Maki  
July 14, 2007

  
**STEVEN D. MAKI**  
**PRIMARY EXAMINER** 7-14-07

**Notice of Non-Compliant  
Amendment (37 CFR 1.121)**

Application No.

10/696,751

Examiner

Steven D. Maki

Applicant(s)

PORTER, JOHN FREDERICK

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1733

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

The amendment document filed on 03 July 2007 is considered non-compliant because it has failed to meet the requirements of 37 CFR 1.121 or 1.4. In order for the amendment document to be compliant, correction of the following item(s) is required.

THE FOLLOWING MARKED (X) ITEM(S) CAUSE THE AMENDMENT DOCUMENT TO BE NON-COMPLIANT:

- ☐ 1. Amendments to the specification:
- ☐ A. Amended paragraph(s) do not include markings.
  - ☐ B. New paragraph(s) should not be underlined.
  - ☐ C. Other \_\_\_\_\_.
- ☐ 2. Abstract:
- ☐ A. Not presented on a separate sheet. 37 CFR 1.72.
  - ☐ B. Other \_\_\_\_\_.
- ☐ 3. Amendments to the drawings:
- ☐ A. The drawings are not properly identified in the top margin as "Replacement Sheet," "New Sheet," or "Annotated Sheet" as required by 37 CFR 1.121(d).
  - ☐ B. The practice of submitting proposed drawing correction has been eliminated. Replacement drawings showing amended figures, without markings, in compliance with 37 CFR 1.84 are required.
  - ☐ C. Other \_\_\_\_\_.
- ☒ 4. Amendments to the claims:
- ☒ A. A complete listing of all of the claims is not present.
  - ☐ B. The listing of claims does not include the text of all pending claims (including withdrawn claims)
  - ☒ C. Each claim has not been provided with the proper status identifier, and as such, the individual status of each claim cannot be identified. Note: the status of every claim must be indicated after its claim number by using one of the following status identifiers: (Original), (Currently amended), (Canceled), (Previously presented), (New), (Not entered), (Withdrawn) and (Withdrawn-currently amended).
  - ☐ D. The claims of this amendment paper have not been presented in ascending numerical order.
  - ☒ E. Other: See Continuation Sheet.
- ☐ 5. Other (e.g., the amendment is unsigned or not signed in accordance with 37 CFR 1.4):  
\_\_\_\_\_

For further explanation of the amendment format required by 37 CFR 1.121, see MPEP § 714.

**TIME PERIODS FOR FILING A REPLY TO THIS NOTICE:**

1. Applicant is given **no new time period** if the non-compliant amendment is an after-final amendment or an amendment filed after allowance. If applicant wishes to resubmit the non-compliant after-final amendment with corrections, the **entire corrected amendment** must be resubmitted.
2. Applicant is given **one month**, or thirty (30) days, whichever is longer, from the mail date of this notice to supply the correction, if the non-compliant amendment is one of the following: a preliminary amendment, a non-final amendment (including a submission for a request for continued examination (RCE) under 37 CFR 1.114), a supplemental amendment filed within a suspension period under 37 CFR 1.103(a) or (c), and an amendment filed in response to a *Quayle* action. If any of above boxes 1. to 4. are checked, the correction required is only the **corrected section** of the non-compliant amendment in compliance with 37 CFR 1.121.

**Extensions of time** are available under 37 CFR 1.136(a) only if the non-compliant amendment is a non-final amendment or an amendment filed in response to a *Quayle* action.

**Failure to timely respond** to this notice will result in:

**Abandonment** of the application if the non-compliant amendment is a non-final amendment or an amendment filed in response to a *Quayle* action; or

**Non-entry** of the amendment if the non-compliant amendment is a preliminary amendment or supplemental amendment.

Legal Instruments Examiner (LIE), if applicable

Telephone No.



Continuation of 4(e) Other: In the amendment filed 7-3-07, claim 31 is not listed, claims 19 and 20 are not correctly identified using the claim identifier "withdrawn", and claim 17 contains minor underlining / strikethrough issues. For example, underlining is not used on line 5 of claim 17 filed 7-3-07 to add ";" after "non woven web". Another example, strikethrough is not used on line 18 of claim 17 filed 7-3-07 to delete the comma after "cementitious material".